

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-19, 21 and 22 will be active in the application subsequent to entry of this Amendment.

As requested by the examiner and following the guidelines provided on page 2 of the Official Action, the specification has been revised to include topical headings. In addition, the Abstract is revised to agree with current requirements and style.

The claims have been amended in order to more particularly point out and distinctly claim that which applicants regard as their invention and to address the issues raised on pages 3 and 4 of the Official Action.

Claim 1 has been amended to remove the recitation of "optionally" as well as the related ingredient and these have been placed in new dependent claims 21 and 22. The expression "o/w" has been replaced with oil-in-water as the examiner kindly suggested. Claims 3, 5, 8, 10 and 12 have been amended to include appropriate Markush terminology and claims 15, 17 and 19 have been amended in a similar manner. The ratio in claim 17 has been clarified, however the claim should be read in accordance with the claims from which it depends. Claim 17 depends from claim 15 which, in turn, depends from claim 1. Claim 17 has been amended to refer to the "already-developed emulsion" which finds direct antecedent basis in claim 15, thus claim 17 is clear as to the basis for the ratio.

Process claims 18 and 19 have been amended to remove the passive voice and state the series of steps in a positive, direct manner.

Claim 20 has been deleted in order to reduce issues.

Page 4, last paragraph, refers to claim 1 and rejects it under 35 USC §101. Counsel believes the examiner intended to refer to claim 20, not claim 1 so in any event claim 20 has been withdrawn and this objection is overcome as well.

The balance of the Official Action includes three separate prior art-based rejections, each directed to a separate prior art document and applied to various claims

under review with the exception of claims 13 and 17 which the examiner regards to be free of the prior art. While applicants appreciate this indication, they believe that their claims, as above amended, are also free of the prior art.

Claim 1 has been amended to include a number of important features – it includes a recitation of the proportion of water-soluble carbohydrate as in original claim 2, the proportion of the hydrocolloid as in original claim 4 and the viscosity of the emulsion as given in the first line of page 10. In addition, the product is described as being whippable consistent with the description at page 4, lines 19-21 (see also lines 24-28). The oil-in-water emulsion is also recited as being protein-free which is based on the description found on page 4, lines 16-18. Accordingly, the amendments made to the claims, as well as new claims 21 and 22, find basis in the original description.

Turning now to the prior art-based rejections, attention will be given to each of the documents applied. Before addressing these however it is appropriate to bear in mind the requirements for establishing anticipation. To anticipate a claim, a single reference must disclose the claimed invention with sufficient clarity to prove its existence in the prior art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Anticipation rejections are only proper when the "claimed subject matter is identically disclosed or described in 'the prior art,' without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972). Absence from the reference of any claimed element negates anticipation *Kloster Speedsteel AB v. Crucible Inc.* 23 USPQ 160 (Fed. Cir. 1986). Campbell does not meet the stringent requirements needed to establish anticipation.

Campbell (5,698,254) discloses a composition which includes 0.1 to 5 wt.% of a protein compound – a required ingredient. Further, Campbell teaches that the best results were obtained, when the emulsion simultaneously comprised at least 10 ppm, preferably at least 50 ppm, of a multi-valent metal (see e.g. column 2, lines 51-54). This is just the opposite to what the present invention tries to achieve (see e.g. page 4, lines 16-18).

Further, Campbell states in column 3, lines 62-64, that his emulsions are so stable that they cannot be whipped. Again this teaching is just the opposite of what the present invention achieves.

Applicant's claims are amended to specify their emulsions are both "whippable" and "protein-free".

Cain (5,659,000) describes a process for the production of confectionery filling compositions in which the fat phase is the continuous phase (a water-in-oil emulsion) just the opposite of applicant's oil-in-water compositions. The water-continuous fat emulsion prepared as an intermediate, is not whippable since phase inversion occurs when the emulsion is exhibited to shear forces.

Applicant's claims specify his emulsions are "whippable" thus the claims distinguish the present invention over Cain. In addition, applicant's claims also include the feature of previous claim 4, namely that the proportion of hydrocolloid is 0.1 to 3 wt.% (relative to the whole emulsion). This concentration is much lower than the 13-85 wt.% taught by Cain.

Rule (4,341,811) discloses a coffee whitener which is liquid when it is added to the coffee. Usually such products are not whippable and accordingly Rule does not mention anything throughout the specification that the disclosed coffee whitener could be whippable. Indeed, this is extremely unlikely since Rule teaches that the coffee whitener has a relatively thin viscosity (column 3, line 3). Thus, the viscosity of the described emulsion is less than about 20 centipoises, at 40°F (column 4, lines 41-43). Accordingly the water content is very high, namely 83% or more (see column 4, lines 37-40 and Example 1).

In contrast to Rule's teaching, the water content of the emulsion according to the present invention is distinctly lower and in any case below 80 wt.% since it contains at least 10 wt.% water-soluble carbohydrate and at least 10 wt.% fat (see page 6, lines 21-23 and page 7, lines 21-23 of the specification). Consequently, the viscosity of the invention according to the present invention is much higher, namely 50-500 mPa•s at 10°C (mPa•s

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equals centipoises), a feature disclosed at page 10, line 1 of the description and now included in claim 1. 10°C corresponds to 50°F, so that the emulsion of the present application has a higher viscosity than the one disclosed in Rule even though the temperature is higher which makes the emulsion thinner and reduces the viscosity.

Since the coffee whitener disclosed in Rule are certainly not whippable, the requirement that the claimed emulsions must be "whippable" distinguishes the claimed subject matter over this reference as does the significant difference in viscosity.

In addition to the above comments, in general there is nothing in any of the three cited references which could suggest the claimed emulsions and their properties. To the contrary, all three references describe properties of their disclosed products which are unsuitable to achieve the objects of the present invention as defined in the specification (see e.g. page 4).

For the above reasons it is respectfully submitted that the claims of this application are in condition for allowance. Reconsideration and favorable action are solicited. If for any reason this Amendment does not place the application in condition for allowance, the examiner is encouraged to contact the undersigned should additional information and documents be required.

Respectfully submitted,

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